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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,835	01/31/2005	Anne Hupp	PAT-01087	6570
77224	7590	12/24/2008	EXAMINER	
Mary E. Golota Cantor Colburn LLP 201 W. Big Beaver Road Suite 1101 Troy, MI 48084			ABU ALI, SHUANGYI	
			ART UNIT	PAPER NUMBER
			1793	
			NOTIFICATION DATE	DELIVERY MODE
			12/24/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/522,835	<b>Applicant(s)</b> HUPP ET AL.	
	<b>Examiner</b> SHUANGYI ABU ALI	<b>Art Unit</b> 1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/26/2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sapper (US 6,284,037) in view of Bergfried (CA 2,154,818).

Sapper discloses an additive for coating formulation with binder used in basecoat materials comprising a nonassociative rheology stabilizer such as exemplified Viscalex HV 30 (like presently used having methacrylic acid content of 40-60 wt %), aluminum pigment, water, polypropylene glycol as nonionic surfactant, mixed with a polyurethane binder (col. 4, lines 25-65). Sapper further teaches the use of tertiary amine compounds such as dimethylethanolamine to control pH (col. 4, line 63 to col. 4, line 5). The amounts of aluminium, nonassociative thickener, and nonionic in the exemplified coating composition overlap with the presently claimed amounts in the coating composition of claim 13.

Sapper does not disclose preparing a pigment paste without binder comprising metallic pigment, nonassociative rheology stabilizer, nonionic surfactant, and amine compounds.

Bergfried discloses a pigment concentrate comprising a pigment, 0-2.0 wt % thickener based on polyacrylate (i.e., Sapper's nonassociative stabilizer), 0.1-0.9 wt % nonionic surfactant, 0.1-4.9 wt % amine, and water (page 3, lines 1-27)—wherein the pigment paste is added to binder resin (page 2, lines 9-12).

Given that Sapper discloses a composition comprising aluminum pigment, nonassociative thickener, nonionic surfactant, amine, and water and further given that pigment pastes are known to contain such ingredients before being added to a binder as taught by Bergfried, it would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition.

With respect to the amount of aluminum pigment, while Sapper discloses an amount of aluminum pigment in a coating composition less than presently claimed and Bergfried discloses an amount of pigment more than presently claimed, it is considered that the amount of pigment is determined by the desired metallic effect and would have been obvious to one of ordinary skill in the art to utilize a suitable amount of aluminium in a pigment paste in order to get the desired metallic effect in a final coating comprising the pigment paste.

Although combined teaching of Sapper and Bergfried et al. are silent about the composition is stable, transportable and storable for up to three month set forth by

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applicant in claims 1 and 16. However, it would be expected the composition of combined teaching of Sapper and Bergfried to have the similar properties since the composition's property is determined by the constituents of the composition absent any evidence to the contrary.

### ***Response to Arguments***

Applicant's arguments filed 09/26/2008 have been fully considered but they are not persuasive.

Applicant argues that the Sapper's polymer is a binder. The Examiner respectfully submits that the polymer in the additive system is used to adjust viscosity and stabilizing coating formulations. In the coating formulation, the binder is used along with the additive. However, that is the reason that Bergfried et al is used to show that pigment paste can be made first, then the paste mixed with binders. The Examiner respectfully submits that Bergfried teaches that the nonassociative rheology stabilizer taught by Sapper can be used to prepare pigment pastes. Given that Sapper discloses a composition comprising aluminum, nonassociative thickener, nonionic surfactant, amine, and water and further given that pigment pastes are known to contain such ingredients before being added to a binder as taught by Bergfried, it would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition. In other words, to mix ingredients in a different order is obvious. Case law holds that the selection of any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 39 F.2d 975, 5 USPQ

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230 (CCPA 1930). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the grinding resin is used in the additive system because dispersing resin is used. The Examiner respectfully submits that the additive system is used to adjust viscosity and stabilizing coating formulations.

Applicant argues that Sapper is not directly to disclose a paste's property. The Examiner respectfully submits that it would be expected the composition of combined teaching of Sapper and Bergfried to have the same properties since the composition's property is determined by the constituents of the composition and absent any evidence to the contrary.

Applicant argues that the pigment used in Bergfried is different from the pigment of instant application. The Examiner respectfully submits that Bergfried is used to show that the pigment paste can be made before the paste is mixed with binders. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Bergfried 's terpolymeric compound is a binder. The Examiner respectfully submits that terpolymeric compound is a surfactant.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sa

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793